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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/932,238	09/17/1997	ICHIRO FUJIEDA	Q46789	5110
7590 11/10/2003				
SUGHRUE MION ZINN MACPEAK & SEAS 2100 PENNSYLVANIA AVENUE NW SUITE 800 WASHINGTON, DC 20037				
EXAMINER LE, QUE TAN				
ART UNIT		PAPER NUMBER		
2878				

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/932,238	FUJIEDA ET AL.	
	Examiner	Art Unit	
	Que T. Le	2878	

-- The MAILING DATE of this communication appears on the cover sheet with corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
 4a) Of the above claim(s) 7-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 43-52 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: ____. |

This is in response to Applicants' amendment filed August 29, 2003.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 43-46, 48-50 and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Funada et al 5,101,099 or the Applicants admitted prior art (Specification pages 7-10 and Fig. 1-6B).

Funada et al disclose an image reading device comprising an image sensor portion (100) having a plurality of light receiving elements (121,122) arranged regularly facing a document (400) to be read out; and a thin film light source (20,241,242,243,244) arranged closely contacted on the document side for emitting light to the document, wherein the light source includes a plurality of light emission portions (243) each having a light emission area (245) smaller than each receiving portion of the light receiving elements (Figures 9 and 11), and opaque electrodes (244) function as a light blocking layer. There at least one of the light emission portions (243) with the light emission area (245) where the light originates is substantially aligned and/or overlapped

with respect to the corresponding light receiving element 121. The light blocking layer is positioned between the document and the light receiving elements.

The Applicants admitted prior art also disclose an image sensor device comprising a plurality of light receiving elements (1612) arranged regularly facing a document (1690) to be read out; and a thin film light source (1620) arranged closely contacted on the document side for emitting light to the document, wherein the light source includes a transparent electrode (1622), a light emission layer (1623), a plurality of light emission windows or light emission portions (1625), and an opaque electrode (1625). The opaque electrode includes a plurality of openings forming light emission portions and light blocking portions with each emission portion having an area smaller than each light receiving portion of the light receiving elements, wherein at least one of the light emission portions where the light originates is substantially aligned and/or overlapped with the corresponding light receiving element (Figures 5-6B). The opaque electrode is disposed between the light receiving elements and the document.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4-6, 47 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funada et al 5,101,099 or the Applicants admitted prior art (Specification pages 7-10 and Figures 1-6B).

Regarding claims 2, 4, 47 and 51, although Funada et al and/or the prior art fail to disclose an organic thin film (insulating layers) with separate organic thin film areas held between the transparent and opaque electrodes, the selection of a prefer material for component(s) of a device would have been a mere matter of obvious design choice to one of ordinary skill in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. The similar selection of the image sensor being cited in claim 4 would have been obvious for similar reasons set forth above.

Regarding claim 5, although Funada et al and/or the prior art fail to specify the colors of light emitted from the light source, using a light source with light of different colors to maximize responsivity of the receiving elements would have been obvious in the art. It would have been obvious to modify Funada et al or the admitted prior art accordingly in order to provide a more reliable reading output from the receiving elements.

Regarding claim 6, although Funada et al and/or the admitted prior art fail to disclose an optical fiber collection member provided between the light source and the document, the use of optical fiber for conducting light in an image sensor is known in the art. It would have been obvious to modify Funada et al or the admitted prior art accordingly in order to minimize possible spurious response from unwanted light.

Applicant's arguments filed August 29, 2003 have been fully considered but they are not persuasive.

With respect to Applicants' comments on page 7 of the remarks regarding layer 1623 of the AAPA which is not aligned with the light receiving elements 1612, it is noted

that at least the opaque electrode 1625 is one of the light emission portions where the light originates is substantially aligned and/or overlapped with the corresponding light receiving element. Also, it is noted that Funada et al reference, Figures 9 and 11, discloses the light emission area 245 and/or opaque electrode 244 is at least one of the light emission portions where the light originates is substantially aligned and/or overlapped with respect to the corresponding light receiving element 121. With respect to Applicants' comments that "The Examiner agreed that this clarifying amendment (filed August 29, 2003) distinguishes the claimed invention from Funada and AAPA", this is an incorrect statement. It is noted that the Examiner only agreed the proposed amendment which Applicants want to amend and/or agreed to have a further consideration if Applicants want to file the amendment as proposed. It also noted that whether the examiner has agreed or approved the proposed amendment from applicant(s), the amendment (of the claimed invention) must overcome the prior art of record.

Accordingly, the rejection set forth above is proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Que T. Le whose telephone number is (703) 308-4830.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Que T Le
Primary Examiner
Art Unit 2878